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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,027	02/19/2004	Ali Unal	370044-00002	4276

7590 09/29/2005

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EXAMINER	
MORILLO, JANELL COMBS	
ART UNIT	PAPER NUMBER
1742	

DATE MAILED: 09/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/782,027	**Applicant(s)** UNAL ET AL.	
	Examiner Janelle Combs-Morillo	**Art Unit** 1742	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 September 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *See Continuation Sheet*. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *1 and 3-32*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☒ Other: Notice of Ref. cited (892)

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Continuation of 3. NOTE: tension leveling and coiling of the aluminum alloy sheet, together with the limitation "without requiring cold rolling prior to the tension leveling and the coiling of the aluminum alloy sheet" has not previously been claimed and would require further consideration.

1. Because the amendment filed 9/6/2005 was not entered, the arguments drawn to the newly amended claims were not considered.

2. Applicant's argument that the present invention is allowable over the prior art of record because the prior art does not teach quenching in-between casting and hot rolling has not been found persuasive. It would have been obvious to one of ordinary skill in the art to quench after casting, as mentioned by Sun, because the prior art teaches that quenching after casting (though less energy efficient) achieves a strong dilute aluminum alloy because substantial precipitation has been prevented (column 1 lines 59-60). Applicant argues that the primary reference of Sun (US 5,769,972) refers to US 5,772,799, which requires hot rolling before quenching. US 5,772,799 does not require hot rolling before quenching, see for instance Example 3- the alloy is strip cast followed by water quenching (column 6 lines 51-52), see also col. 7 lines 29-30 of US 5,772,799. Therefore, it is clear that the primary reference of Sun (US 5,769,972) refers to US 5,772,799, which teaches that quenching after casting (though less energy efficient) achieves a strong dilute aluminum alloy because substantial precipitation has been prevented (see Sun at column 1 lines 59-60).

3. Concerning the argument that the prior art does not teach a preferred embodiment within the scope of the instant claims, a reference disclosure must be evaluated for all that it fairly suggests and not only for what is indicated as preferred, In re Boe, 53 CCPA 1079, 335 F.2d 961, 148 USPQ 507 (1966), see also MPEP 2123. "The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain." In re Heck, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d

1006, 1009, 158 USPQ 275, 277 (CCPA 1968)). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. Merck & Co. v. Biocraft Laboratories, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). See also Celeritas Technologies Ltd. v. Rockwell International Corp., 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998) (The court held that the prior art anticipated the claims even though it taught away from the claimed invention. "The fact that a modem with a single carrier data signal is shown to be less than optimal does not vitiate the fact that it is disclosed.").

4. Additionally, though the prior art does not specify "quenching" the feedstock to temperature of about 400-900°F between casting and before rolling, because the prior art teaches the hot rolling temperature is < the temperature of casting molten aluminum, then the prior art necessarily teaches cooling in-between casting and hot rolling, wherein said cooling is to the hot rolling temperature, which overlaps the presently claimed range of 400-900°F (see final rejection mailed 6/2/2005). The instant limitation of "quenching" is given it's broadest reasonable interpretation consistent with the specification. See *In re Morris*, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997). See MPEP §2111 - §2116.01. In doing so, the examiner has not read any limitations of the specification, or any preferred embodiment or example therein, into the claims. See generally, *Morris, supra*; *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); *In re Priest*, 582 F.2d 33, 37, 199 USPQ 11, 15 (CCPA 1978). In the instant case, quenching is held to cover a variety of cooling rates/quenchant media including: liquid quenching (water, polymer, etc.), forced air quenching, spray quenching, still air quenching, etc. Cooling between casting and hot rolling by air quenching in a continuous in line process taught

by the Figures of the prior art (see also discussion above and the Final rejection mailed 6/2/2005) meets said "quenching" limitation.

5. Applicant's argument that the present invention is allowable over the prior art of record because the prior art does not teach a process for making a T or O temper alloy has not been found persuasive. The prior art teaches the application of annealing and/or solution heating treatments (see Final rejection for details), thereby providing said temper conditions. More particularly, see "ASM Vol. 4 Heat Treating" p 840, 878-879 for background on the relationship between tempers and heat treatment processes. T type tempers are described as products thermally treated by cooling from elevated temperature shaping process or solution heat treatment (see p 878-879), while O type tempers are alloys heat treated by annealing, thereby obtaining a low strength temper (p 878). Concerning applicant's arguments of claims 28-32, Wyatt-Mair teaches steps of annealing (a heating process that causes recrystallization, Wyatt Mair at column 2 lines 52-53) and solution heat treating (dissolving alloying elements into solid solution, column 2 lines 56-57). Wyatt Mair is held to teach an intermediate product with an annealed O type temper. Because Wyatt Mair further teaches a solution heat treating step after annealing, Wyatt Mair is also held to teach a product with a T type temper.

6. Applicant's argument that there is no motivation to alter the method of Wyatt Mair into a method of alternating criteria, has not been found persuasive. The application of a T or O type temper is held to meet the limitation of steps iv and v of claim 28 of selectively proceeding and selectively quenching to provide T or O type tempers.

7. Applicant's argues (p 14) that the examiner submitted in the final rejection that Wyatt-Mair teaches casting at 400-900°F. The range of 400-900°F refers to applicant's claimed range.

More particularly, as seen in the final rejection p 5 1st full paragraph, Wyatt-Mair necessarily teaches cooling in-between casting and hot rolling, wherein said cooling is to the hot rolling temperature of >600-1000°F, which overlaps the presently claimed range of 400-900°F.

8. Applicant's argument that the present invention is allowable over the prior art of record because Zonker teaches a slow cooling rate has not been found persuasive. Applicant refers to quenching step after, not before, hot rolling. Zonker teaches water quenching before hot rolling at column 5 line 62. The motivation to apply said step is found in the final rejection.

When the Examiner has established a *prima facie* obviousness, the burden then shifts to the applicant to rebut. *In re Dillon*, 919 F.2d 688, 692, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (en banc). Rebuttal may take the form of "a comparison of test data showing that the claimed compositions possess unexpectedly improved properties... that the prior art does not have, that the prior art is so deficient that there is no motivation to make what might otherwise appear to be obvious changes, or any other argument.. that is pertinent." Id. at 692-93; USPQ2d 1901. Evidence of unexpected properties may be in the form of a direct or indirect comparison of the claimed invention with the closest prior art which is commensurate in scope with the claims. See In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980) and MPEP §716.02(d) - § 716.02(e). Applicant has not clearly shown specific evidence of unexpected results.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janelle Combs-Morillo whose telephone number is (571) 272-1240. The examiner can normally be reached on 8:30 am- 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GEORGE WYSZOMIERSKI
PRIMARY EXAMINER
GROUP 1700

JCM
September 23, 2005